

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

David E. MCDYSAN et al.

Application No.: 09/723,501

Group Art Unit: 2157

Filed: November 28, 2000

Examiner: Gold, A.

Attorney Docket: RIC00043

Client Docket: 09710_1236

For: EXTERNAL PROCESSOR FOR A DISTRIBUTED NETWORK ACCESS SYSTEM

REPLY BRIEF

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed July 17, 2007.

I. STATUS OF THE CLAIMS

Claims 2-18 and 20-38 are pending and are on appeal.

II. GROUND S OF REJECTION TO BE REVIEWED

Whether claims 2-6, 9, 20-24, 27, 37, and 38 are anticipated under 35 U.S.C § 102 based on *Miles et al.* (US 6,665,495)?

Whether claims 7, 8, 10, 11, 25, 26, 28, and 29 are obvious under 35 U.S.C § 103 based on *Miles et al.* (US 6,665,495) in view of *Gai et al.* (US 6,167,445)?

Whether claims 12, 13, 30, and 31 are obvious under 35 U.S.C § 103 based on *Miles et al.* (US 6,665,495) in view of *Bullock et al.* (US 6,631,414)?

Whether claims 14-18 and 32-36 are obvious under 35 U.S.C § 103 based on *Miles et al.* (US 6,665,495) in view of *Bowman-Amuah* (US 6,442,547)?

III. ISSUE

There is a single issue on appeal. That issue is whether the Declaration filed under 37 CFR § 1.131 (Declaration) is sufficient to remove *Miles et al.* as a reference against the claims.

IV. ARGUMENT

Appellants maintain and incorporate the positions presented in the Appeal Brief filed March 23, 2007, but present further refutation of certain assertions presented in the Examiner's Answer.

It appears from the Answer that the Examiner now accepts that the Declaration contains the proper signatures (Answer-page 13) and that the proper due diligence has been shown (Answer-page 15-“Thus, exhibit M proves due diligence.”). Accordingly, the only issue remaining with regard to the Declaration is whether there is a proper showing of conception of the claimed invention prior to October 27, 2000, the effective filing date of *Miles et al.*

It is the Examiner's view that Appellants' statements in the Declaration with regard to conception are “[v]ague and general statements (Answer-page 13) and that “[i]n items 5-16 of the declaration the Appellant has done nothing other than point to over 90 pages as proof of conception without any explanation of what facts are established in the exhibits and used in the claims” (Answer-page 14). In particular, the Examiner points to specific language in claim 37, *viz.*, “generates a control signal according to the policy” and “configuring a PAD to enforce the policy with respect to a network connection between a first network and a second network,” that

has allegedly not been shown to have been conceived prior to the crucial date of October 27, 2000.

Appellants strongly dispute the Examiner's allegations. Exhibit A of the Declaration offers 34 pages of very detailed drawings and descriptions of subject matter including that recited in the present claims on appeal. In particular, to answer the Examiner's concerns, at page 4 of Exhibit A, for example, on the page containing a diagram of an "External Service Control of Programmable Access Device," paragraph B recites, in part, "...Finally, the message interpretation, signaling, admission control, and **policy invocation** is implemented in SC's on external processors." This comports directly to the now claimed "wherein the service controller determines a policy based on the message and **generates a control signal according to the policy**" of claim 37. With regard to the Examiner's concern with conception of "configuring a PAD to enforce the policy with respect to a network connection between a first network and a second network," as recited in claim 37, this comports with the disclosure in Exhibit A, for example, at paragraph C on page 4, that recites:

The **Programmable Access Device** and **SC** enable customer applications to reserve bandwidth, perform admission control, and prioritize traffic streams based upon available capacity and **policy controls**. These **policy controls** may be initiated by the provider or the customer organization...If the PAD is located on the extreme edge of the network, then the external processor can signal for access capacity. This network-based provisioning **invoked by policy control** replaces time-consuming and error-prone OSS provisioning.

At page 6 of Exhibit A, second paragraph, for example, it is recited, "A service controller is able to interpret service-specific messages and **invoke the appropriate policy control** and network signaling procedure. The service controller **configures the PAD** using MCRI **according to the policy decisions** received from the Policy Server..."

Moreover, at page 8 of Exhibit A, there is a “Figure A.3 External Processor” which clearly shows the PADs, the Message Control & Reporting Interface, and a Service Policy, connected between two networks, i.e., either end of the block diagram indicates “To Network.” Clearly, these exemplary disclosures, and there are more indications within Exhibit A, show that Appellants had conceived the claimed features of “generates a control signal according to the policy” and “configuring a PAD to enforce the policy with respect to a network connection between a first network and a second network,” as well as the rest of the claimed subject matter, at the time Appellants prepared this disclosure form.

From merely a cursory perusal of Exhibit A, for example, it should be abundantly clear that this disclosure form of Exhibit A provided a disclosure, hence a conception, of the now-claimed invention at that time.

If the Examiner’s concern is that there is no date shown on the papers of Exhibit A, Appellants note that all dates have been redacted, as is conventionally done in patent cases for legal reasons, but Appellants, i.e., the inventors, have sworn under oath that the description was prepared “long prior to the effective date of October 27, 2000” (see paragraph 5 of the Declaration). As Appellants indicated in the Appeal Brief of March 23, 2007, the Examiner’s summary dismissal of the Declaration submitted under 37 CFR § 1.131, in the face of Appellants’ sworn statements, is tantamount to accusing the inventors of lying under oath, without any basis for doing so.

Exhibit A of the Declaration goes to painstaking lengths to show that the inventors had conceived of the presently claimed invention at the time of preparation of the disclosure statement, and that Exhibit, taken together with the inventors’ sworn statement that they “conceived our invention in this country long prior to October 27, 2000...” (Declaration –

paragraph 4) and “Long prior to October 27, 2000, we prepared a description of our invention, a copy of which is attached hereto (Exhibit A). Although the dates of inventor signatures, headers, footers, and additional descriptive material has been redacted, we attest that the description was prepared long prior to the effective date of October 27, 2000” (Declaration – paragraph 5), is evidence of conception of the presently claimed subject matter prior to the effective date of the primary reference to *Miles et al.*

Based upon the foregoing and the reasons set forth in the Appeal Brief of March 23, 2007, it is submitted that the Examiner’s disposition of the Declaration submitted under 37 CFR § 1.131 is clearly legally erroneous. Appellants further submit that the Declaration clearly and effectively removes *Miles et al.* as a reference against the claims on appeal, thereby overcoming the imposed rejection of claims 2-6, 9, 20-24, 27, 37, and 38 under 35 U.S.C. § 102 for lack of novelty as evidenced by *Miles et al.*

In the absence of *Miles et al.*, the secondary references to *Gai et al.*, *Bullock et al.*, and *Bowman-Amuah* cannot support a *prima facie* basis to deny patentability to the claimed invention under any statutory provision. Thus, the rejections of claims 7, 8, 10-18, 25, 26, and 28-36 under 35 U.S.C. § 103 must also fall.

V. SUMMARY

In summary, the Declaration submitted under 37 CFR § 1.131 is effective to remove *Miles et al.* as a reference by demonstrating prior invention prior to the effective date of *Miles et al.* Hence, none of the imposed rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 are factually or legally viable.

VI. CONCLUSION AND PRAYER FOR RELIEF


Based on the foregoing, Appellants respectfully solicit the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

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8/15/07

Date



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